



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,186	12/15/2003	Nobuo Sugino	F-8063	4328

28107 7590 09/26/2006
JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
SUITE 4000
NEW YORK, NY 10168

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,186	Applicant(s) SUGINO, NOBUO	
	Examiner Frederick J. Parker	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22, 25-30 and 35-44 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 31-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Specification

The amendments in response to the Objections to the Abstract and Specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections. The substitute specification is acknowledged and entered.

Claim Objections

The amendments in response to the Claim Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections. Previous claims were cancelled and replaced by new claims 20-44.

Claim Objections

1. Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 40 does not further limit claim 30 which already includes a roller as the device.

Claim Rejections - 35 USC § 112

The amendments in response to the Rejections under 35 USC 112 of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections. Previous claims were cancelled and replaced by claims 20-44.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1762

3. Claims 21, 23,24,30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 21-23 are vague and indefinite because it defines canvas to be one of drawing paper, cotton or other non- canvas cloth which is repugnant to the term canvas which has a specific art-understood meaning. For examination, any cloth, paper, or other substrate as disclosed by the prior art having a mesh without size limitation will be considered to meet Applicants limitation of “canvas” or “canvas body”.

- Claims 23,24 are vague and indefinite because the relative term “tiny” is ambiguous, is not understandable by one of ordinary skill, and is not defined by the specification.
- Claim 30 is vague and indefinite because it is unclear how a roller is not also a device.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35,36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Martin.

Martin teaches a method of pounding flowers to transfer pigment from the flora into fabric, paper, etc using pressure of hammering (a hammer is a “device”). Fabrics cited explicitly include synthetic and natural fiber materials, particularly canvas, because it receives impressions very well (top, page 11). Flora laid onto a cloth surface may be covered with plastic (inherently a

Art Unit: 1762

synthetic resin) and using hammering pressure to cause the pigment to flow from the plant matter to the underlying fabric (page 17. Following the process the unneeded overlain hammered plant matter and plastic is removed (top page 28). The reference therefore meets all the limitations of claim 35.

Further the reference teaches on the top of page 29 to post-treat the imaged product to prevent fading, which is simply a change of color, thereby meeting all the limitations of claim 36.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 20-22,25-30,37,38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin.

Martin is cited for the same reasons in the previous paragraph.

Art Unit: 1762

Page 28 teaches applying a second project fabric onto a first fabric so that during hammering both absorb the plant pigment, thereby creating dual images. Since a fabric is a mesh configuration, and this teaching puts the second fabric between the first fabric (which may be canvas) and the plant matter to be hammered with a plastic sheet thereon, Martin teaches the limitations of the independent claims. Alternatively, the use of a second fabric or mesh-like fabric to receive pigment to make dual or desired images would have been an obvious variation of Martin to form dual images or alter absorbency of the plant pigments being transferred.

Per claim 21-22, Martin teaches pretreating substrates with aqueous solutions comprising mordents to cause substrates to more readily absorb pigments, including pH modifying alum (pages 23-24).

Per claims 25-27, fabrics and meshes are not limited by Martin and therefore include those of the claim. Rigid backings are cited (pages 15-16) per claim 26. Plants are not scratched in Martin which meets the limitations of claim 28.

9. Claims 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin.

Martin is cited for the same reasons previously discussed, which are incorporated herein. Martin explicitly teaches applying pressure to flowers and other plant matter to transfer the pigments outward by pressure/ force. However, it is apparent from page 15 that any source of pressure/ force which provides the same outcome is suitable, and hence it is the Examiner's position that any functionally equivalent conventional, and suitable means to do so, such as rollers and spatulas, would have been obvious variations of Martin because of the expectation of successfully achieving similar results using such functionally equivalent means.

Art Unit: 1762

10. The prior art does not teach nor suggest the process for plaster or other board or unglazed ceramic in conjunction with the recited pH setting solutions of claims 23-24, nor the use of an after-treating fixing solution as defined by claims 31-34. Claims 23,24,31-34 are objected to for depending from a rejected base claim.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

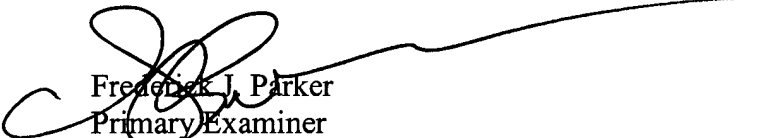
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp